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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,975	02/25/2004	Manoj Ajbani	DN2003-213	4119

7590 04/27/2005

The Goodyear Tire & Rubber Company  
Patent & Trademark Department - D/823  
1144 East Market Street  
Akron, OH 44316-0001

EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/786,975

Applicant(s)

AJBANI ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11-15-04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1104.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-44, drawn to a vinylaromatic/diolefin block copolymer composition, classified in class 525, subclass 99.
- II. Claim 45 is, drawn to a polyisobutene block copolymer composition, classified in class 525, subclass 88.

The inventions are distinct, each from the other because:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions of group I and II are not disclosed to be usable together.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

During a telephone conversation with Alvin Rockhill on 4-20-05 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-44. Affirmation of this election must be made by applicant in replying to this Office action. Claim 45 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 1-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation of "void of thermoplastic resins" is contradictory to the requirement of a vinyl aromatic/diene block copolymer since these materials are often referred to in the art as "thermoplastic" elastomers.

Claim 19 recites only two monomers, not three as implied by "terpolymer".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 11, 13, 14, 17, 18, 29, 30, 32, 36 and 40-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakaki et al. (pregrant publication 2002/0077409).

Patentees in Examples 1-4 disclose dynamic vulcanization of SEPS and EPDM with TACKIROL phenolic (column 9, lines 60-65). Note applicants block copolymer molecular weights at column 8, lines 6-9.

Claims 10, 12, 15, 16, 19, 20, 22-28, 31, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaki et al., cited above in view of Medsker et al (US 6169145) , Coran et al. (either US 6,437,030 or 4,271,049) and Medsker (US 6,084,031).

The primary reference does not disclose peroxide curing, applicants specific acrylate rubbers, stearate cure or hydrogenation of non block rubbers.

Medsker '145 discloses vulcanization using hydrosilation using acrylate rubbers in order to improve lubricity and other surface properties (abstract).

Coran disclose the use of stearates with phenolics in a vulcanization process in order to improve hygroscopic properties (column 2, lines 8-11 of '030 and table II for stearate use).

Medskar '031 discloses the equivalence of peroxide and phenolics for vulcanization at column 2, line 60.

It would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention to use Medskers' hydrosilation process for vulcanization to

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produce the composition of the primary reference in the expectation of extending the benefits of medsker to Sakaki et al., absent any showing of surprising or unexpected results.

Use of stearates in Sakakis' process as taught by Coran would have been obvious to a practitioner having an ordinary skill in order to improve hygroscopic properties as taught by Coran.

Use of stearates in Sakakis' process would have been obvious to a practitioner having an ordinary skill since a Medsker ('031) discloses the equivalences of the phenolics of the primary reference and peroxides and in the expectation of unexpected results.

With regard to hydrogenation of the rubbers of Sasaki, higher stability is disclosed by Azizian at column 1, lines 15-20 and thus hydrogenation of Sakakis' similar rubber would have been obvious to a practitioner to increase stability, absent any showing of surprising or unexpected results.

Claims 9, 20, 21, 33-35 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

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Jeffrey C. Mullis  
J Mullis  
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JCM

4-22-05

A handwritten signature in black ink, appearing to be 'JCM', written in a cursive style.

**Jeffrey Mullis  
Primary Examiner  
Art Unit 1711**